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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,444	08/16/2001	Robert Alan Neubert	200489-902	2624

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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,444	NEUBERT, ROBERT ALAN	
	Examiner	Art Unit	
	Olabode Akintola	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to application's election of Group 1 (claims 1-9 and 19-23).

Claims 10-18 have been withdrawn from consideration.

Claim Objections

Claims 1, 4, 19 and 22 are objected to because of the following informalities: In claims 1 and 19, the words "receive" and "select" should be "receiving" and "selecting" respectively. In claims 4 and 22, the "a" preceding the word "agreed" should be "an". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-19 and 22-23 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble of the claim 1 refers to a system, but the body of the claim discusses the process steps ("identifying..., providing..., receiving..., selecting..."). Also, dependent claims 22-23 recite a system, but the independent claim 19 recites

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a method. A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 19-23 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

Re claim 1: The claim begins by discussing a system (ex. Preamble of claims 1), the body of the claim discusses process steps ("identifying..., providing..., receiving..., selecting...") (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", *Ex parte Lyell* (17USPQ2d 1548).

For examination purpose, the examiner will give these claims their broadest interpretation and treat claims 1-9, 22-23 as process/method claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Brobst et al (USPN'6687708) (Brobst).

Re claim 1: Brobst teaches a system for exploiting discount opportunities relating to invoices billed from a supplier to a buyer, the invoices having invoice terms which state a discount price if the invoice is paid within a discount period and a full price of the invoice is not paid within the discount period, the system comprising the steps of: identifying invoices which have discount prices associated with payment of the invoice during the discount period (col. 5, lines 15-16 and 45-64); providing information relating to the invoices on which discounts are available to prospective bidders (col. 5, lines 26-30); receiving bids from respective potential bidders which indicate the bidders terms upon which the respective potential bidders will pay the invoices during the discount period (col. 4, lines 65-67); select a winning bidder from the respective potential bidders, the winning bidder is selected based upon select criteria, whereby if no respective potential bidders meet the select criteria, no winning bidder will be selected (col. 5,

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lines 26-30).

Re claim 2: Brobst teaches wherein the winning bidder pays the discount price of the invoice before the end of a discount period, and the supplier receives payment of the discount price before the end of the discount period (col. 11, lines 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brobst as applied to claim 1 above, and further in view of Mason (USPAP 20010051919) (Mason).

Re claims 3 and 9: Brobst does not explicitly teach wherein the buyer pays the full price of the

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invoice after the discount period has expired; wherein a discount agent uses the internet for the bidding process. Mason teaches this step (section [0010]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brobst to include the step as taught by mason. One would have been motivated to do so in order to encourage the buyer to pay on time.

Re claim 4: Brobst teaches wherein the winning bidder is paid the discount price plus an agreed upon return after the buyer has paid the full price of the invoice (col. 13, lines 13-25; col. 15, lines 40-42).

Re claim 5: Mason teaches wherein the buyer receives a rebate after the full price of the invoice has been paid (section [0010]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brobst to include the step as taught by Mason. One would have been motivated to do so in order to encourage the buyer to pay on time.

Claims 6-8 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brobst as applied to claim 1 above, and further in view of Rackson et al (USPN 6415270) (Rackson).

Re claims 6-8 and 19: Brobst does not explicitly teach wherein the potential bidders are pre-qualified and assigned a numerical code to indicate preferences on the type of invoices on which the respective potential bidder will bid; wherein the invoice is numerically coded according to

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appropriate criteria; wherein the numerical coding of the potential bidders and the numerical coding of the invoice is compared, whereby only invoices which meet the respective bidders preferences will be sent to that respective bidder. Rackson teaches wherein the potential bidders are assigned a numerical code to indicate preferences on the type of invoices on which the respective potential bidder will bid (col. 23, lines 30-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brobst to include these steps as taught by Rackson. One would have been motivated to do so in order to ensure that only selected items types are offered to the bidders for bidding.

Brobst does not explicitly teach wherein the potential bidders are pre-qualified. Official notice is hereby taken that it is old and well known to pre-qualify potential bidders. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brobst to include this step in order to ensure that only qualified bidder are able to bid for the item.

Re claim 20: See claim 2, analysis, supra.

Re claim 21: See claim 3, analysis, supra.

Re claim 22: See claim 4, analysis, supra.

Re claim 23: See claim 5, analysis, supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571- 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER